UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,337	09/16/2003	Keiko Shiraishi	117194	9255

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EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/662,337	SHIRAISHI ET AL.
	Examiner	Art Unit	
	Manglesh M. Patel	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 September 2003*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-16* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *16 September 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *Feb 9, 2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This **Non-Final** action is responsive to communications: IDS filed on Feb 9, 2004 to the

application filed on September 16, 2003.

2.   Claims 1-16 are pending. Claims 1, 10, 11, 12, 13 and 16 are independent claims.

Information Disclosure Statement

3.   The information disclosure statement (IDS) submitted on Feb 9, 2004 has been entered,

and considered by the examiner.

Priority

4.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 2003-081354 JP,

filed on 03/24/03.

Drawings

5.   The Drawings filed on September 16, 2003have been approved.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-10, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rivera (U.S. Pub 2004/0003353,with provisional date May 14, 2002) in view of Thomason (U.S.

Pub 2003/0023625 filed on Jul 27, 2001).

Regarding Independent claims 1, 10, 13 and 16, Rivera discloses An

instruction form retrieval apparatus comprising [¶ 7-10, Rivera States "Once the Digital

Form is retrieved by the user"]: a storage part that stores user information and

information on an instruction form management apparatus holding an

instruction form accessible to the user [¶ 7-10, Rivera States "After completing the user supplied

new information sections of the Digital form, the user, along with all associated tracking and authentication

information, are extracted from the fields in the Digital Form and used to populate a record or data tables in a relational

database" & "The Workflow Integration System is typically implemented as part of an integrated data management

process to thereby provide a scalable solution to an organization's data management needs." wherein the database

stores the user information which is the information supplied by the user thereby providing access to the instruction

form which is part of the Workflow Integration System performing the functions of a management apparatus],

associated with each other [¶ 20, Rivera States "In this environment, users, who may be customers or

personnel of the organization, access the Work-flow Integration System 100 to retrieve information stored in the data

management system 200, or input new information to the data management system 200, or update information that is

resident in the data management system 200" wherein although Rivera mentions tracking and authentication

information being part of the input information he doesn't explicitly disclose user information, However Thomason

states ¶ 5-7, "The present disclosure relates to a method for completing forms. In one arrangement, the method

comprises the steps of receiving location information for user information to be added to a form, retrieving the user

information, configuring the user information for merging with the form, and printing a form that contains at least a

portion of the user information" wherein the user information is added to a form, therefore Thomason teaches the use of

user information stored and related to the form.], an input part that inputs information on a

user who instructs an instruction form execution apparatus to execute

processing indicated in the instruction form [Abstract Rivera states "A Digital Form can be

processed simultaneously by multiple users to thereby speed execution of a task and associated documents can bind to

the Digital form to enable the compilation in real time of a complete transaction record that is routed electronically

through the workflow process" wherein the users process the execution of a task]; and a retrieval part that

retrieves information on the instruction form management apparatus holding

the instruction form accessible to the user based on the information on the

user input by the input part [¶ 7-10, Rivera States "The digital forms can be self-populating in whole or

part, in that the relational database extracts the relevant data from its records and/or tables and automatically populates

the associated fields within the digital form to simplify the task for the user" wherein the database retrieves information

on the workflow integration system which includes the forms that are accessible by the user]. A processing

part that executes the processing on the instruction form accessible to the

user retrieved by the retrieval part [¶ 17, Rivera states "One or more of the data processors 210 can

serve data terminals that are located within the physical premises of the organization and data links (not shown) can

interconnect remotely located data processors (not shown) with the elements shown in FIG. 2." Wherein the form is

processed]. *Rivera suggests data input by the user which includes tracking and*

authentication information however Thomason explicitly teaches user

information. At the time of the invention it would have been obvious to a person

of ordinary skill in the art to associated user information with a form. The

motivation for doing so would have been to allow the system to automatically

retrieve user information from a database to fill in the remainder of the form,

thereby saving time. Therefore it would have been obvious to combine the

teachings of Thomason with Rivera for the benefits of allowing an instruction

form retrieval apparatus including user information thereby reducing the amount

of information the user must manually provide on the form.

Regarding Dependent claim 2, with dependency of claim 1, Rivera discloses

an output part that outputs information on the instruction form management

apparatus retrieved by the retrieval part to the instruction form execution

apparatus used by the user [¶ 7-10 & 20, Rivera states "The Workflow Integration System 100,

illustrated in block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the

coordination, processing, validation, assimilation and dissemination of information that is managed by the data

management system 200" wherein the output is the dissemination of the information on the Workflow integration

system retrieved from the database to the form being supplied to the user].

Regarding Dependent claim 3, with dependency of claim 1, Rivera discloses

an output part that outputs the information on the instruction form

management apparatus retrieved by the retrieval part to a terminal used by the user [¶ 7-10 & 17, Rivera states "One or more of the data processors 210 can serve data terminals...." & The Workflow Integration System 100, illustrated in block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the coordination, processing, validation, assimilation and dissemination of information that is managed by the data management system 200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the database to the form being supplied to the user terminal] .

Regarding Dependent claim 4, with dependency of claim 1, Rivera discloses an output part that outputs a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the information on the instruction form management apparatus retrieved by the retrieval part [¶ 7-10 & 20, Rivera states "The Workflow Integration System 100, illustrated in block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the coordination, processing, validation, assimilation and dissemination of information that is managed by the data management system 200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the database to the form being supplied to the user based on the information instructions of the integration system retrieved from the database].

Regarding Dependent claim 5, with dependency of claim 1, Rivera discloses an output part that outputs a command to the instruction form management

apparatus to transmit the instruction form accessible to the user to a terminal

used by the user, based on the information on the instruction form

management apparatus retrieved by the retrieval part [¶ 7-10 & 17, Rivera states "One or

more of the data processors 210 can serve data terminals...." & The Workflow Integration System 100, illustrated in

block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the coordination,

processing, validation, assimilation and dissemination of information that is managed by the data management system

200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the

database to the form being supplied to the user terminal based on the information instructions of the integration system

retrieved from the database] .

Regarding Dependent claim 6, with dependency of claim 2, Rivera discloses

wherein the information on the instruction form management apparatus

output from the output part is information on the instruction form

management apparatus holding the instruction form [¶ 7-10, wherein the information that

is disseminated includes information of the integration system holding the form].

Regarding Dependent claim 7, with dependency of claim 2, Rivera discloses

wherein the information on the instruction form management apparatus

outputted from the output part includes information to discriminate the

instruction form [¶ 7-10, wherein the information includes information for changing the form].

Regarding Dependent claim 8, with dependency of claim 1, Rivera discloses

wherein user authentication is performed using the information on the user [¶

7-10, & 20, Rivera States "In this environment, users, who may be customers or personnel of the organization, access

the Work-flow Integration System 100 to retrieve information stored in the data management system 200, or input new

information to the data management system 200, or update information that is resident in the data management system

200" Rivera States "After completing the user supplied new information sections of the Digital form, the user, along

with all associated tracking and authentication information, are extracted from the fields in the Digital Form and used

to populate a record or data tables in a relational database" wherein Rivera mentions tracking and authentication

information being part of the input information].

Regarding Dependent claim 9, with dependency of claim 1, Rivera discloses

a display information generation part that generates information to display

the retrieved information on the instruction form management apparatus [¶ 7-

10, 20 & 23, Rivera States "The user requests access to a Digital Form via a user interface and the Digital Form is then

displayed on the user's data terminal device" wherein the information is displayed to the user on the form integration

system].

8.   Claims 11-12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thomason (U.S. Pub 2003/0023625 filed on Jul 27, 2001) in view of Rivera (U.S. Pub

2004/0003353,with provisional date May 14, 2002).

Regarding Independent claims 11 and 12, Thomason discloses An

instruction form execution apparatus comprising: an attachment part that

attaches a storage medium [¶ 37, Thomason states "Once the various user information has been stored, location information pertinent to the location of the stored information can be stored on the data card 112..." wherein the storage medium is the card], which is unique to a predetermined user [¶ 37 & 38, Thomason states "As indicated in decision element 610, it can then be determined whether a passcode is required to retrieve the user information" wherein the passcode makes the card unique to the user], holding information on an instruction form management apparatus holding an instruction form accessible to the user [¶ 38-39, Thomason states "Once the location information is read, the user information can be retrieved, as indicated in block 616, by visiting the pertinent location and collecting this information. Again, by way of example, this information can be retrieved from a database 314 of one or more of the remote computing devices 104 or the database 424 of the local computing device 110. At this point, flow continues to block 618 of FIG. 6B at which the user information is configured for merging with one or more forms stored locally within the printing device 102 or local computing device 110" wherein although Thomason mentions retrieving information from the database including the form he fails to disclose the instruction management apparatus used to access the form], *Rivera discloses* an input part that inputs the instruction form accessible to the user from the instruction form management apparatus [¶ 20, Rivera States "In this environment, users, who may be customers or personnel of the organization, access the Work-flow Integration System 100 to retrieve information stored in the data management system 200, or input new information to the data management system 200, or update information that is resident in the data management system 200" wherein Rivera input is received from the user in numeral 401 figure 4 (user log in)], based on the information on the instruction form management apparatus [¶ 20, Rivera States "input new information to the data management system" wherein the management system includes the forms]; and an execution part that executes processing indicated in the input instruction form [¶ 7-10 & 20, Rivera states "The Workflow Integration System 100, illustrated in block diagram form in Fig1,

executes on one or more of the data processors 201, 206-211 to manage the coordination, processing, validation, assimilation and dissemination of information that is managed by the data management system 200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the database to the form being supplied to the user]. *At the time of the invention it would have been obvious to a person of ordinary skill in the art to have included a management system for accessing the form. The motivation for doing so would have been to allow the system to update/change records in the form by accessing a management system. Therefore it would have been obvious to combine the teachings of Rivera with Thomason for the benefits of allowing an instruction form execution apparatus including a management system thereby allowing the accessing/updating of forms.*

Regarding Dependent claim 14, with dependency of claim 13, Thomason fails to teach a management apparatus. *Rivera discloses* the outputting of discloses outputting the retrieved information on the instruction form management apparatus to the instruction form execution apparatus used by the user [¶ 7-10 & 20, Rivera states "The Workflow Integration System 100, illustrated in block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the coordination, processing, validation, assimilation and dissemination of information that is managed by the data management system 200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the database to the form being supplied to the user].

Regarding Dependent claim 15, with dependency of claim 13, Thomason fails to teach a management apparatus. *Rivera discloses* outputting a command to the instruction form management apparatus to transmit the instruction form accessible to the user to the instruction form execution apparatus used by the user, based on the retrieved information on the instruction form management apparatus [¶ 7-10 & 20, Rivera states "The Workflow Integration System 100, illustrated in block diagram form in Fig1, executes on one or more of the data processors 201, 206-211 to manage the coordination, processing, validation, assimilation and dissemination of information that is managed by the data management system 200" wherein the output is the dissemination of the information on the Workflow integration system retrieved from the database to the form being supplied to the user based on the information instructions of the integration system retrieved from the database].

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Conclusion

Other Prior Art Cited

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fujii et al. (U.S. Pub 2003/0079008) discloses "Content Distribution System, Content Reserved-Time-Extension Control Apparatus, Content..."

- Lee (U.S. Pub 2003/0192008) discloses "System And Method For Comprising Manual Function For Managing A Form"

- Shuster (U.S. Pub 2002/0059370) discloses "Method And Apparatus For Delivering Content Via Information Retrieval Devices"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner
March 16, 2006

**CESAR PAULA
PRIMARY EXAMINER**